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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/841,756	04/24/2001	Michael Schoenbaum	6847-127 / 10100727	6868
167 7590 02/28/2007 FULBRIGHT AND JAWORSKI LLP 555 S. FLOWER STREET, 41ST FLOOR LOS ANGELES, CA 90071			EXAMINER MORGAN, ROBERT W	
			ART UNIT 3626	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		02/28/2007	PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

09/841,756

Applicant(s)

SCHOENBAUM ET AL.

Examiner

Robert W. Morgan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 7-13 and 19-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 7-13 and 19-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### *Notice to Applicant*

1. In the amendment filed 9/1/06 the following has occurred: Claims 7, 19, 20 and 24-25 have been amended. Claims 7-13 and 19-25 are presented for examination.

### *Claim Rejections - 35 USC § 101*

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 8-13 and 19 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. According to MPEP 2106, the claimed invention as a whole must produce a “useful, concrete and tangible” result to have a practical application in order to be considered statutory. The purpose of this requirement is to limit patent protection to inventions that possess a certain level of “real world” value, as opposed to subject matter that represents nothing more than an idea or concept, or is simply a starting point for future investigation or research ((*Brenner v. Manson*, 383 U.S. 519, 528-36 (1966); *In re Ziegler*, 992 F.2d 1197, 1200-03 (Fed. Cir. 1993)). Accordingly, a complete disclosure should contain some indication of the practical application for the claimed invention, i.e., why the applicant believes the claimed invention is useful.

In this case, independent claim 8 recites the limitation “processing data and performing numerical solutions with a central processing unit” and “formulating a consumer’s objective function which maximizes expected namely equation”. However, the claim does not appear to be (i) specific, (ii) substantial and (iii) credible therefore, the examiner has reason to believe that the claim is not for a practical application that produces a useful result. For example, the performing

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of numerical solutions does not use a specific equation to calculate the optimal flexible saving account contribution. Therefore, the claims do not appear to be specific, substantial and credible and are thus, not considered useful.

In addition, the limitations discussed above are also considered not tangible, as they do not provide a “real world” result to the user. For example, an equation is not displayed or identify prior to being used to perform numerical solutions.

Therefore, claim 8 is considered not useful and not tangible and are thus, directed to non-statutory subject matter and dependent claims 9-13 are directed to similar non-statutory subject matter and are rejected for the same reasons given above.

Additionally, independent claim 19 recites the limitation “which is then solved by numerical calculation method for optimal flexible account contribution”. However, the claim does not appear to accomplish a practical application or to provide “real world” result. For example, a computer is not actually used to perform the numerical calculation methods but could be perform on paper or in a human mind, providing no real world use.

Therefore, claim 19 is considered not tangible and is thus, directed to non-statutory subject matter.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 19 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the

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specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. After reviewing the specification the Examiner could not find enablement for claim subject of "solved by numerical calculation methods for optimal flexible account contribution". It is not clear what means is responsible for performing the calculation as no computer is mention to perform the second calculation.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 20-25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As per claim 20, it is unclear whether the applicant intends to claim a computer-based system for calculating optimal saving account contributions or numerical model solved using numerical methods on the central processing unit. The current claim language suggests that the Applicant is attempting to claim a product-by-process or product-by-system (system, method and computer-based system for calculating optimal saving account contributions). However, it should be noted that only the components from the computer-based system which affect the calculating of the optimal saving.

In *IPXL Holdings, L.L.C. v Amazon.Com, Inc.* (CAFC, 05-1009, -1487, 11/21/2005), the court held a claim covering two statutory classes to be properly rejected under 112,<sup>2nd</sup> paragraph:

Whether a single claim covering both an apparatus and a method of use of that apparatus is invalid is an issue of first impression in this court. The Board of Patent Appeals and Interferences ("Board") of the PTO, however, has made it clear that reciting both an apparatus and a method of using that apparatus renders a

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claim indefinite under section 112, paragraph 2. Ex parte Lyell, 17 USPQ2d 1548 (BPAI 1990). As the Board noted in Lyell, "the statutory class of invention is important in determining patentability and infringement." Id. at 1550 (citing In re Kuehl, 475 F.2d 658, 665 (CCPA 1973); Rubber Co. v. Goodyear, 76 U.S. 788, 796 (1870)). The Board correctly surmised that, as a result of the combination of two separate statutory classes of invention, a manufacturer or seller of the claimed apparatus would not know from the claim whether it might also be liable for contributory infringement because a buyer or user of the apparatus later performs the claimed method of using the apparatus. Id. Thus, such a claim "is not sufficiently precise to provide competitors with an accurate determination of the 'metes and bounds' of protection involved" and is "ambiguous and properly rejected" under section 112, paragraph 2. Id. at 1550-51. This rule is well recognized and has been incorporated into the PTO's Manual of Patent Examination Procedure. § 2173.05(p)(II) (1999) ("A single claim which claims both an apparatus and the method steps of using the apparatus is indefinite under 35 U.S.C. 112, second paragraph."); see also Robert C. Faber, Landis on Mechanics of Patent Claim Drafting § 60A (2001) ("Never mix claim types to different classes of invention in a single claim.").

As such, the Examiner is interpreting the claims to mean that the Applicant is claiming a computer-based system for calculating optimal saving account contributions, *not* the numerical model solved using numerical methods on the central processing unit. Therefore, limitations, which further define the computer-based system but do not appear in the numerical methods (i.e. the numerical model such as the equations used to solve the optimal saving account contributions) will not receive patentable weight. (See MPEP 2113).

As per claim 25, it combines two separate statutory classes by claiming dependency on the "method of claim 20", while claim 20 is directed to a computer-based system.

**NOTE:** For purposes of applying art, the examiner interprets the claims as best as possible in light of the plurality of 101 and 112 issues.

### ***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 7-13 and 19-25 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 7,133,840 to Kenna et al.

As per claims 7-13 and 19-25, Kenna et al. teaches computer system for managing a plurality of accounts and at least one subaccount being a medical saving account (MSA) (see: abstract). In addition, Kenna et al. teaches that money for the MSA may come from the subscriber's employer, a professional associated to which the account-holder belongs, or the from the subscriber himself (see: column 8, lines 53 to column 13, lines 24). Further more, Kenna et al. teaches that funds may be pre-funded at the beginning of a plan year or periodic contributions may be made during the year (see: column 13, lines 10-18).

#### ***Response to Arguments***

7. Applicant's arguments with respect to claims 7-13 and 19-25 have been considered but are moot in view of the new ground(s) of rejection.

#### ***Conclusion***

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert W. Morgan whose telephone number is (571) 272-6773.

The examiner can normally be reached on 8:30 a.m. - 5:00 p.m. Mon - Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on (571) 272-6776. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

*Robert Morgan*  
Robert Morgan  
Patent Examiner  
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